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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,474	05/26/2000	Charles Philippe Tresser	YO999-486	9995

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MCGINN & GIBB, PLLC  
8321 OLD COURTHOUSE ROAD  
SUITE 200  
VIENNA, VA 22182-3817

EXAMINER

HUSEMAN, MARIANNE

ART UNIT PAPER NUMBER

3621

DATE MAILED: 01/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/578,474

Applicant(s)

TRESSER, CHARLES PHILIPPE

Examiner

M. Huseman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1 - 37 have been considered but are moot in view of the new ground(s) of rejection. It is noted that while some of the 35 USC § 112 second paragraph problems have been resolved, Applicant did not review all of the claims as requested in the previous office action. Therefore, there are still problems with this application. The Examiner, in this office action, has further identified more issues that need to be resolved, but again, not all of the issues are pointed out in this action. Applicant is requested to review all of the claims, not only the ones particularly pointed out by the Examiner.

### ***Drawings***

2. Applicant has stated that a corrected drawing was sent with the response to the last office action but, the drawing does not appear to be with the amendment. However, the Examiner has located drawings, filed 9/13/2000, within this application that are acceptable. Therefore, Applicant is not required to re-submit drawings.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 6, 13 and 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 6:

It is not clear from the specification as to what is meant by business "unit".

Regarding claim 13:

It is not clear from the specification as to what is meant by the claimed feature "removing clear identification thereof ...tagging by a number which has redundancy allowing the business entity..."; i.e., the specification essentially repeats the claim

language without defining what and/or from what clear identification is being removed, what Applicant is "tagging" nor what Applicant means by "redundancy".

Also, it is not clear from the specification as to what exactly is being exchanged; i.e. on page 10, it is stated that "the paying bank accepts the money transfer in exchange of the tag coded using a private key of the payee's bank", but it is not known as to what "the tag coded" represents.

Regarding claim 43:

It is not clear from the specification as to what is meant by "the relationship... remains fixed"; i.e., neither the term "fixed" nor any equivalent terms are used in the specification that would clarify the language used in Applicant's claim.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6, 11 – 35 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, it is not clear as to what is meant by business "unit". Is "unit" different from "entity"?

In claim 11, line 1, there is no proper antecedent basis for "sending application" as there is no limitation/mention in claim 2 of an application.

In claim 12, lines 2 – 3, there is no proper antecedent basis for "the relevant data encrypted using pu1(l)". Further, after pu1(l), a period needs to be inserted.

In claim 13, there is no proper antecedent basis for "all completed applications".

In claim 13, it is not clear as to what represents "thereof"; i.e., it is not clear as to what is being removed. It is also not clear as to what is being tagged. See paragraph 3, above.

In claim 14, there is no proper antecedent basis for "the paying party", "the transaction order", "the money transfer" and "the tag coded".

In claim 14, it is not clear as to what is meant by "accepts the money transfer in exchange of the tag coded using..."; what exactly is being exchanged.

In claim 16, there is no proper antecedent basis for "when submitting a transaction request" as there is no mention in any of the previous pertinent claims of submitting a transaction request.

In claim 24, it is not clear as to what is meant by "sending... an application along with software which allows encrypting..."; i.e., what does Applicant mean by software? Or, perhaps Applicant means sending... an application utilizing software which allows (or enables) encrypting.

In claim 43, it is not clear as to what is meant by "the relationship... remains fixed". See paragraph 3, above.

Again, and as stated in the first office action, most of Applicant's claims are indefinite, failing to conform to current U.S. practice. They are replete with grammatical and idiomatic errors. Applicant is respectfully requested to review and correct all applicable claims. This applies to all of Applicant's claims (i.e., claims 1 – 35 and the newly added claim 43).

While some of the claims have been considered on their merits, others could not as it is not clear to the Examiner exactly what is being claimed. Applicant is respectfully requested to review this Application and correct for any such remaining grammatical and idiomatic errors.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 – 5, 15, 38 - 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Niwa.

Regarding claims 1, 3, 15, 38 and 40:

Niwa discloses a method of using a personal device in conducting transactions over a network such that Applicant's third party reads on element 10, Applicant's first

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party reads on the customer, element 52, Applicant's second party reads on a merchant, element 62, and Applicant's step of providing the second party with information identifying said first party only as a transactional party in said electronic business transaction reads on the authorization given to the merchant by the settlement bank, element 10.

Regarding claims 2, 5 and 39:

Applicant's proprietary item reads on the portable device, element 50, and Applicant's information identifying the customer reads on the authorization code generated by the portable device, element 50.

Regarding claim 4:

Applicant's fourth party reads on the payor bank, element 10.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 8, 24, 41, 42 and 44 - 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa in view of Henley.

Regarding claims 7, 41 and 42:

Niwa teaches the use of a portable device for the purpose of authenticating the user (owner of the device). Henley teaches a system (business entity), element 16, for providing medical services from a plurality of providers (verifiers), element 83, to a user, wherein the user is required to pay for (i.e., insurance or out-of-pocket) the services and hence, must authenticate himself to the provider. It is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Niwa to include the specifics of the provider selection arrangement of Henley and use the device of Niwa for purposes of user authentication to the providers as user authentication is old and well known to be a requirement of any type of business transaction.

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Regarding claims 44 - 46:

Applicant's fourth party reads on the payor bank, element 10, and the portable device, element 50 of Niwa.

Regarding claims 8 and 24:

Henley teaches that the buyer (customer) can register on-line, pages 7 – 8, paragraph [0098].

Although neither Niwa nor Henley specifically teach the type of encryption used for communications between the parties, it is considered to be old and well known that a customer will have software that will enable him to encrypt any private information (application) using the public key of the recipient (business entity) as is done using public key encryption (public signature scheme). Therefore, it is considered that it would have been obvious, if not inherent, to modify the combined teachings of Niwa and Henley to include public key encryption for the purpose of encrypting the information passed between the parties as a matter of design choice.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maury et al and French et al teach systems for furnishing users with on-line insurance quotes.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Huseman whose telephone number is 703-605-4277.

The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

M. Huseman  
Examiner  
Art Unit 3621

mh  
January 20, 2003



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600